

**REMARKS**

Counsel for the applicants thanks the examiner for the courtesy of the telephone interview on 7 May 2009. The following incorporates matters discussed at the interview.

The applicants acknowledge receipt of an initialed copy of the Supplemental Information Disclosure Statement filed on 11 December 2008.

Claims 1, 11 and 14-21 are pending. Claim 2 is canceled. Claims 20 and 21 are new. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 1, 2, 11, 14, 15, and 17-19 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 5,832,460, Bednar *et al.* ("Bednar") in view of U.S. Patent No. 6,289,322, Kitchen *et al.* ("Kitchen"). Claim 16 was rejected under 35 USC 103(a) as being unpatentable over Bednar and Kitchen, further in view of Quicken vs. Money from SmartComputing ("Quicken"). Independent claims 1 and 11 are amended to recite "the supplier uses only the unique identification code in the electronic deposit/withdrawal statement to confirm that the payment has been settled." Support for the amendment is located in the application as filed, for example, paragraphs [0077], [0088], [0141], and [0154]. The applicants respectfully request that the rejections be withdrawn for reasons including the following, which are presented by way of example.

**Independent Claims 1 and 11**

In the invention according to independent claims 1 and 11, when a buyer approves an electronic invoice, a proper transfer request message with the correct amount of payment is automatically generated. The message includes the unique identifier which is identical to the one included in the approved electronic invoice. The original unique identifier is eventually returned

to the supplier system that generated it **and can be trusted as correctly confirming that the payment has actually been settled**. In comparison, in the prior art such as the cited reference, the payment notification cannot be trusted as confirming that the payment has actually been made, so that the supplier must still confirm the actual payment amount, name and invoice data.

In the telephone interview, the examiner indicated that Bednar FIG. 2, elements 205, 206, 207 and col. 2, line 66 to col. 3, line 2 can be interpreted to say that payment has actually been made. However, nothing in this portion of Bednar discloses the recited sequence. Furthermore, Bednar col. 3, lines 5-8 expressly teaches that the supplier still needs to compare the payment notification messages and the reconciled payments. That is, Bednar specifically teaches that the payment notification cannot be trusted. ("Meanwhile, the electronic bill presenter 200 has sent a message 207 indicating the reconciled payments to the bill originator for comparison with the payment notification message 206 received from the bill originator's bank 104." (col. 3, lines 5-8).) Hence, Bednar's payment notification has a different function than the recited electronic deposit/withdrawal statement.

Moreover, according to Bednar FIG. 3, steps 311 and 312, the bill payment is reported before it is paid. Because Bednar's sequence allows the bill payment to be reported before it is paid, Bednar discloses that payment notification message 206 must be confirmed against the reconciled payments.

In other words, Bednar's payment is being done at a different sequence than is reflected in the claims, and has a different function. Furthermore, Bednar requires an extra step (comparing message 207 with payment notification message 206) to confirm that the payment has actually been settled. Copies of discussion drawings titled "Examiner's Opinion" and "The Present Invention" are attached to compare the sequences, and were discussed at the interview.

Note that in the examiner's combination of references, Sequence S16, the deposit/withdrawal detail is sent, and the supplier can reconcile the invoice automatically using the returned ID. In comparison, in the inventor's Sequence S5, the supplier is notified of the payment in progress before it is paid.

The applicant also wishes to point out that the present invention is intended to help suppliers. Specifically, the present invention can make it possible to significantly reduce the burden required to handle electronic invoices. Since it is possible to specify the invoice relying only on the unique identification code, the burden of the supplier is greatly reduced in comparison with the situation that the supplier reconciles the invoice by also checking, e.g., the payer's name and amount. In the present invention, the ID issued from the supplier and approved by the buyer is returned directly to the supplier through the server, the buyer's bank, and the supplier's bank. Consequently:

(1) When a transfer request telegraphic message concerning the invoice approved by the buyer is prepared, the invoice's ID is included in the telegraphic message; and

(2) The ID is transferred from the buyer's bank to the supplier's bank along with the transfer of the amount from the buyer's account to the supplier's account.

Because of above point (1), the telegraphic message with the ID is sent to the buyer's bank. Therefore, it is possible to transfer the ID from the buyer's bank to the supplier's bank and send the ID to the supplier along with the deposit/withdrawal statement from the supplier's bank to the supplier.

Furthermore, the invoice can be "reconciled" first after the reception of the amount in the supplier's account is confirmed. As suggested in point (2) above, the ID is transferred from the buyer's bank to the supplier's bank along with the transfer of the amount. Therefore, the fact

that the ID is returned to supplier guarantees that the amount billed has actually been received in the supplier's account.

That is, in a system according to the claimed invention, the following are guaranteed:

- The ID issued from the supplier is directly returned without being changed on the way to the transfer.
- The fact that the ID is returned to the supplier means that the amount in the invoice corresponding to the ID has actually been received in the supplier's account.

As a result, the supplier can automatically reconcile the invoice that is specified by using the returned ID (see step S17 in attached Figure).

In summary, the proposed combination of references fails to teach or suggest the invention as claimed reciting, in combination, at least:

- "wherein said supplier receives, from the second finance system, the electronic deposit/withdrawal statement having said unique identification code generated by the supplier system; ... the supplier uses *only the unique identification code* in the electronic deposit/withdrawal statement to confirm that the payment has been settled."

Applicant further notes that the examiner has failed to find a proper reason to combine.

Citing from MPEP 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with *no change in their respective functions*, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396. *If any of these findings cannot be made, then this rationale cannot be used to support a*

**conclusion that the claim would have been obvious to one of ordinary skill in the art.**

With respect to the amended claims, it is respectfully submitted that the office action is defective for failing to comply with *KSR*, as enunciated in MPEP 2143. The proposed combination would change the function of the elements in the cited references, e.g., the payment notification message 206.

Quoting from the Board Decision of *In re Massey* (provided to the examiner with the prior response):

“given the disparity of problems addressed by the applied prior art references, and the differing solutions proposed by them, any attempt to combined them in the manner proposed by the Examiner could only come from Appellant’s own disclosure ... even assuming, *arguendo*, that proper motivation were established for the Examiner’s proposed combination of references, we fail to see how and in what manner the references could be combined to arrive at the specific combination set forth in the appealed independent claims.”

Though not binding precedent, the reasoning is apt. With regard to the proposed combination of Bednar, Kitchen, and/or Quicken, the applicant relies on the reasoning of *In re Masse* as persuasive for the contention that given the different solution proposed by the applied references, the attempt to combine them in the manner proposed by the examiner could only come from the present disclosure and not from any teaching or suggestion in the references themselves.

The combination of references fails to teach or suggest, for example, these elements recited in independent claims 1 and 11. It is respectfully submitted therefore that claims 1 and 11 are patentable over the combination of references.

With respect to the rejected dependent claims, applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claims 1 or 11, but also because of additional features they recite in combination.

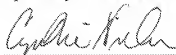
Claims 20 and 21 are new. Support for the claims is located in the application as filed, for example, paragraphs [0077], [0088], [141], [0154], and others. Claims 20 and 21 depend from independent claims 1 and 11 and are believed to be patentable for reasons including those discussed above, in addition to further limitations recited in the claims which are not present in the references.

Applicants respectfully submit that, as described above, the cited references do not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited references show any of the elements recited in the claims. However, applicants have provided specific examples of elements in the claims that are clearly not present in the cited references.

In view of the foregoing, the applicants submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions arise, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

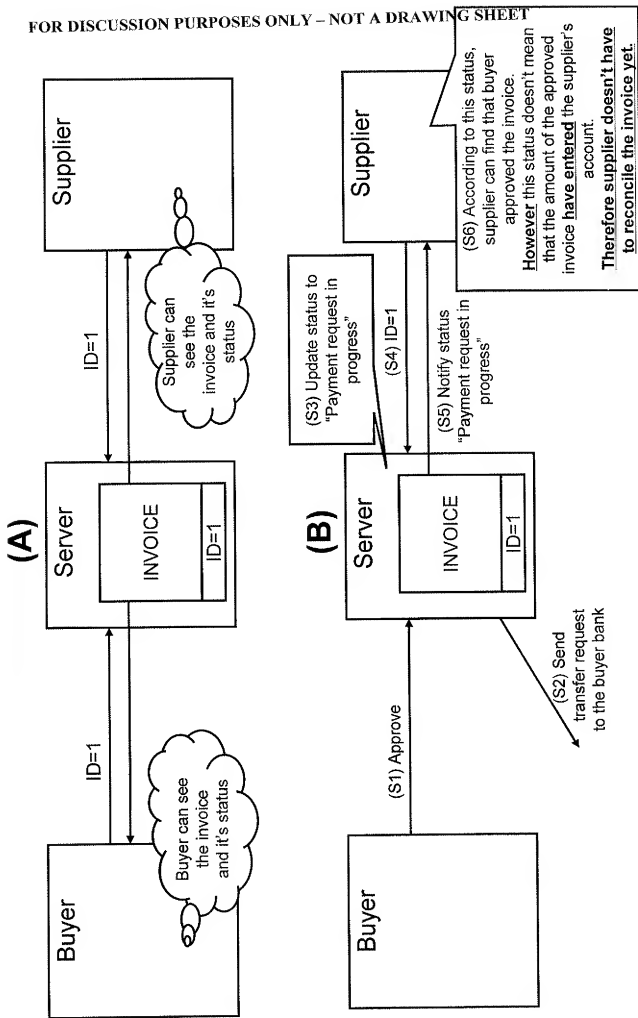
Respectfully submitted,



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## Examiner's opinion



## The present invention

